

REMARKS

Status of Claims and Amendment

Claim 6 has been amended. Claims 1-6 are all the claims pending in the application.

Claim 6 is rejected.

Claim 6 has been amended to recite that the “active ingredient selected from the group consisting of theanine, genisteine, L-carnitine and caffeine, and optionally catechin, wherein the theanine, genistein, L-carnitine and caffeine is present in an amount of 0.0001 wt% to 20 wt% of the total weight of the composition.” Support for this amendment may be found, for example, at Experimental Examples 5-8, Figs. 6 and 7, and page 7, lines 13-16.

No new matter is added..

Response To Rejection under 35 U.S.C. § 112

Claim 6 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. This is a new matter rejection.

The Office Action asserts that the new limitations added to the claims by Applicants raise the issue of new matter because the new limitations are not allegedly described in the specification as filed. Specifically, the Office Action asserts that there is no disclosure in the specification regarding the term “consisting essentially of” in the context of the claimed composition.

Initially, Applicants note that support for the amendments to claim 5 are explicitly supported in the specification, for example, at Experimental Examples 5-8, Figs. 6 and 7, and page 7, lines 13-16, as mentioned in the Amendment filed December 19, 2007. It would have been apparent and understood by one of ordinary skill in the art at the time the application was filed, from reading at least these disclosures in the specification, that the ingredients, theanine, genisteine, L-carnitine and at least one active ingredient selected from caffeine and catechin are

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/554,050 (Q90861)

essential and material to the anti-cellulite composition for removing cellulite by reducing the activity of glycerol-3-phosphate dehydrogenase (GPDH). Accordingly, Applicants have shown possession of the claimed invention by describing the claimed invention with all of its limitations. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Further, the Examiner is reminded that the “absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 112, para[graph] 1, for lack of adequate written description.” M.P.E.P. 2163. Thus, not only are the recited ingredients explicitly supported in the as filed specification in the context of the claimed composition, and would be understood by one of ordinary skill in the art that Applicants had possession of the claimed composition at the time the application was filed, but the Office Action’s rejection based solely on the lack of disclosure of the term “consisting essentially of” is an improper basis for a written description rejection.

Reconsideration and withdrawal of the rejection under § 112, first paragraph, is respectfully requested.

Response To Rejection under 35 U.S.C. § 103

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spiegel (U.S. Publication No. 2004/0082657) and in view of Ingram (U.S. Publication No. 2002/0010141).

Spiegel appears to be asserted by the Office Action for the same reasons set forth in the Office Action mailed June 6, 2008. For brevity, these reasons are not reiterated herein. In addition, the Office Action appears to assert that the claimed effective amount would have been obvious to one of ordinary skill in the art because one of ordinary skill in the art would have been motivated to vary and/or optimize the dosage amount of about 0.1 to about 10.0 mg/kg/day disclosed in Spiegel to obtain the presently claimed amount.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/554,050 (Q90861)

Ingram appears to be asserted by the Office Action for administering an isoflavone to suppress weight gain, induce weight loss, or impart a feeling of gastric fullness in a subject. Specifically, Ingram appears to be asserted for teaching genistein, and administration of an effective amount of isoflavone in the range of about 5 to about 500 mg/day. The Office Action again asserts that it would have been obvious for one of ordinary skill in the art to vary and/or optimize the dosage disclosed in Ingram to obtain the presently claimed amount.

Thus, the Office Action concludes that the claimed composition is *prima facie* obvious because one of ordinary skill in the art would have been motivated to make the presently claimed composition that has a slimming effect based upon the disclosures of Spiegel and Ingram, and the knowledge in the art of “the well known ingredients for medicinal and cosmetic uses, most notably for their anti-suppressant properties to offset the losing of weight by those who are in need of such a composition.” (See page 7, lines 3-5 of the present Office Action).

In response, Applicants note that the Office Action has failed to establish a *prima facie* case of obviousness for at least the following reasons.

First, the combination of Spiegel and Ingram do not teach or suggest all of the claim limitations. M.P.E.P. § 2143.

As previously argued, Spiegel does not teach or suggest genisteine or catechin. Ingram does not cure the deficiencies of Spiegel because although Ingram discloses genistein, Ingram does not teach or suggest catechin¹. Thus, the combination of Spiegel and Ingram does not teach or suggest each and every element of the claimed invention. Furthermore, because Spiegel is directed to suppressing appetite (see Abstract of Spiegel) and Ingram is directed to controlling

¹ Ingram also does not teach or suggest theanine and L-carnitine.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/554,050 (Q90861)

weight gain and/or inducing weight loss by suppressing appetite or food consumption (see Abstract), neither Spiegel nor Ingram teach or suggest removal of cellulite by reducing the activity of glycerol-3-phosphate dehydrogenase (GPDH), as claimed. Accordingly, one of ordinary skill in the art would not have been motivated to combine Spiegel and Ingram to arrive at the claimed anti-cellulite composition. However, even if one of ordinary skill in the art was somehow motivated to combine Spiegel and Ingram, the combination would not result in the claimed anti-cellulite composition.

Also, Spiegel explicitly teaches away from using caffeine (see last sentence of paragraph [0014] of Spiegel). Similarly, Ingram explicitly teaches away from using caffeine because the method of Ingram “avoids the disadvantages associated with stimulant weight-loss drugs, such as caffeine and amphetamine.” (See Abstract of Ingram).

Further, with regard to the Office Action’s assertions that one of ordinary skill in the art would have optimized the dosage ranges disclosed in Spiegel and Ingram to obtain the presently claimed amount of 0.0001 wt% to 20 wt% of the total weight of the claimed composition, Applicants note that the Office Action has failed to point to any teaching in either Ingram or Spiegel, or provide an explanation based on scientific rationale that modifying the dosage ranges disclosed in Spiegel or Ingram would result in the desired removal of cellulite by reducing the activity of glycerol-3-phosphate dehydrogenase (GPDH), as claimed. See *In re Whalen* (BPAI 2008).

In fact, there would have been no reasonable basis for one of ordinary skill in the art to “optimize” the dosages of Spiegel and Ingram based upon the disclosures in each. This is because the dosage ranges disclosed in Spiegel (see paragraph [0017] and Abstract of Spiegel) and Ingram (see paragraphs [0025] and [0029] of Ingram) are for oral administration to suppress

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Application No. 10/554,050 (Q90861)

appetite (see Abstract of Spiegel), suppress weight gain or induce weight loss (see paragraph [0010] of Ingram), whereas the claimed composition is for external use to remove cellulite. Thus, one of ordinary skill in the art would not have been motivated or have reason to “optimize” the dosages disclosed in Spiegel and Ingram to the presently claimed amount which is used for topical application.

Reconsideration and withdrawal of the rejection under § 103(a) is respectfully requested.

**AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/554,050 (Q90861)**

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. The U.S. Patent and Trademark Office is hereby directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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